

### **REMARKS**

This Amendment is in response to the Office Action mailed 12/29/2005. In the Office Action, the Examiner rejected claims 1-19 under 35 U.S.C. § 103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Drawings***

2. The Examiner objects to the drawings as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "21" (e.g. ¶ 0020, l. 1). Applicant has amended Figures 1 through 6 to add a reference sign "21" for the punch head as described in the specification as filed. The reference sign "20" has been moved so that it more clearly indicates the punching station, which includes the punch head and the supporting member as described in the specification as filed. The changes are shown with a yellow highlight in an annotated copy of the amended figures.

3. The Examiner objects to the drawings as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both a pair of rollers (e.g. ¶ 0019, l. 12) and supporting members (e.g. ¶ 0020, l. 5). Applicant has amended Figures 1 through 6 to change the reference number applied to the supporting members from "12" to --23--. Paragraph [0020] of the specification is amended to reflect this change. The changes are shown with a yellow highlight in an annotated copy of the amended figures.

4. The Examiner objects to the drawings under 37 CFR 1.83(a) because they fail to show the control system as described in the specification (¶¶ 0040-0042). Applicant has added Figure 11 showing an embodiment as described in the specification as filed. Figure 11 shows a punching station for a web of the same type as shown in Figures 7 through 10. The toolbars 50, 52 are shown as having moved along the arcuate paths 60, 62 beyond the position shown in

Figure 10 to a position that will withdraw the punch 56 from the web 10 and then release the resilient clamp 54. [0038] The embodiment shown in Figure 11 includes a control system 70. [0039] A velocity sensor 72 is shown providing input for the speed of the web to the control system 70. [0040] A motor 78 to control the motion of the punching station is shown. [0040] A pair of drive rollers 76 to control the speed of the portion of the web 10 adjacent the punching station are shown. [0040] A feature sensor 74 is shown to sense a periodic reference mark on the web and provide input to the control system 70. [0042] The control system 70 is shown providing outputs to the motor 78, controlling the motion of the punching station, and to the pair of drive rollers 76, controlling the motion of the web 10 adjacent the punching station. [0042] Figure 11 is shown in a yellow box in the annotated figures to indicate that it has been added.

5. The Examiner makes similar objections to the description in ¶¶ 0040-0042 of the specification and the drawings under 37 CFR 1.84(p)(5) supra. Applicant has thoroughly reviewed the application to insure correspondence of the reference numerals between the specification and the amended drawings. Applicant respectfully submits that all reference sign mentioned in the description are now shown in the Figures as amended.

6. The Examiner objects to the drawings under 37 CFR 1.83(a) as not showing the sensor and reference mark (claims 3, 12, and 18); punch actuator (claim 6); and "means for advancing the portion..." (claim 14). Applicant respectfully submits that the sensor 74 is now shown in Figure 11. Applicant respectfully submits that the reference mark is not claimed as a feature of the invention and only appears in the claim to further define the sensor. Thus, applicant submits that there is no requirement to show a reference mark. Applicant respectfully submits that the punch actuator in the form of a motor 78 that controls the motion of the punching station is now shown in Figure 11. Applicant respectfully submits that the clamps 32,

36 in the embodiment of Figures 1-6 and the clamps 54 in the embodiment of Figures 7-11 are examples of "means for advancing the portion..." [0022]

Applicant respectfully requests that the Examiner accept the changes to the drawings and withdraw the objections.

***Claim Rejections - 35 USC § 112***

8. The Examiner rejects claims 6-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 6 calls for a punch actuator each punch actuator to move in arcuate paths. The Examiner asserts that, due to the lack of a corresponding drawing Figure, it is impossible to ascertain what mechanism or means allow for such movement, and thus concludes that the claims are nonenabling. Applicant respectfully disagrees.

The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). (MPEP § 2164.01 Test of Enablement) The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970). (MPEP § 2164.02 Working Example)

Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for lack of enablement of claim 6 because the Examiner has not provided specific technical reasons why one skilled in the art could not develop mechanism or means to cause the toolbars to move along arcuate paths without undue experimentation. (MPEP § 2164.04 Burden on the

Examiner Under the Enablement Requirement) Applicant submits that mechanisms and means for moving a mechanical part along an arcuate path are well known in the art of machinery design.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 6-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

10. The Examiner rejects claims 1-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i. The Examiner considers claim 1 to be vague and indefinite because it appears that differing rates of movement between the web transport and the clamp are associated with the second embodiment of Figs. 7-10 and not with the first embodiment of Figs. 1-6. The Examiner considers that substantially the same applies to claims 8 and 14. Applicant respectfully submits that differing rates of movement between the web transport and the clamp are associated with the first embodiment of Figs. 1-6 as well as the second embodiment of Figs. 7-10. In the first embodiment, punch head 21 moves with a reciprocating motion. [0020] During the portion of the operating cycle when the web is punched, the punch head is moving in the same direction as the web and at substantially the same speed as the web. [0023, emphasis added] If the web moves against the punch while the punch is penetrating the web, the web may tear or crumple. [0008] Thus, the punch head must be moving at exactly the same speed as the web while the punch is penetrating the web. The invention provides a method and apparatus for accomplishing this without the need to stop the web by gripping the web so that the portion of the web being punched moves in unison with the punch head rather than with the bulk of the web.

ii. The Examiner considers claim 3 to be vague and indefinite with regard to the "sensor" and "reference mark." The Examiner considers that substantially the same applies to similar claims. Applicant respectfully submits this rejection is addressed by the drawing amendments supra.

iii. The Examiner considers claim 6 to be vague and indefinite because the phrase "the opposite side of the web from the first tool bar" lacks clear antecedent basis because no "side" has been set forth to provide reference for the "opposite". Applicant has amended claim 6 to provide a first and second side of the web, the second side being defined with reference to the first side.

Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Conclusion***

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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**/James Henry/**

Dated: 03/28/2006

By \_\_\_\_\_

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Attachments: 3 Replacement Sheets  
3 Annotated Sheets Showing Changes